

**REMARKS****I. General**

Claims 1-77 were pending in the application, and all of such claims were rejected in the Office Action mailed January 9, 2004. The issues raised in the present Office Action are:

- Claims 1-3, 5-20, 28-43, 46, and 48-70 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Published U.S. Patent Application Number 2002/0055866 A1 of Dewar (hereinafter "*Dewar*");
- Claims 4, 22-27, 44, 45, 47, and 72-77 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dewar* in view of U.S. Patent Number 5,978,768 issued to McGovern et al. (hereinafter "*McGovern*"); and
- Claims 21 and 71 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dewar* in view of U.S. Patent Number 6,064,977 issued to Haverstock et al. (hereinafter "*Haverstock*").

In response, Applicant respectfully traverses the outstanding claim rejections, and requests reconsideration and withdrawal thereof in light of the amendments and remarks presented herein.

**II. Record of Examiner Interview**

Applicant's attorney thanks the Examiner for his time and consideration in the telephone interview conducted February 11, 2004. Applicant respectfully submits the following record of this interview under M.P.E.P. § 713.04:

The following persons participated in the interview: Examiner Jonathan Oellette and Applicant's attorney, Jody Bishop. During the interview, claim 1 and the *Dewar Provisional* reference (60/211,044) were discussed. Applicant's attorney asserted that the *Dewar Provisional* reference fails to teach a computer program that generates a customized application for interacting with candidates. These arguments are re-presented herein below for the Examiner's further consideration. No agreement was reached in the interview.

### III. Claim Amendments

Claims 30, 34, 54, and 62 are amended herein, and new claims 78-87 are added. No new matter is added by these amendments and claim additions.

More specifically, independent claim 30 is amended to further recite that the desired hiring criteria “specifies at least one attribute to be possessed by a candidate to be considered qualified for a position of employment”. In view of this amendment to claim 30, dependent claim 34 is amended to recite “wherein said at least one attribute includes an attribute concerning one selected from the group ....”

Claim 54 is amended to recite “code for presenting a user interface for receiving preferences from said employer regarding operational characteristics of at least one qualification program to be generated”. Claim 54 is further amended to recite that the code for generating at least one qualification program is “in accordance with said received preferences”.

Claim 62 is amended to further recite “said desired hiring criteria defining at least one attribute desired to be possessed by a candidate to be considered qualified for a position of employment”.

### IV. Claim Rejections Under 35 U.S.C. § 103(a) over *Dewar*

Claims 1-3, 5-20, 28-43, 46, and 48-70 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dewar*. As detailed further in Applicant’s previous response (mailed October 3, 2003), *Dewar* is a published U.S. patent application having a filing date of June 12, 2001, which claims the benefit of a provisional patent application having a filing date of June 12, 2000, and only the subject matter that was actually present in the provisional patent application (referred to hereafter as “*Dewar Provisional*”) is afforded the earlier date of June 12, 2000. Thus, Applicant addresses the above rejection with regard to *Dewar Provisional* hereafter.

Also, Applicant does not concede that *Dewar Provisional* is prior art to Applicant’s claimed invention, but reserves the right to overcome this rejection by antedating the filing date of *Dewar Provisional* by submitting a declaration in accordance with 37 C.F.R. § 1.131.

In any case, as discussed further below, *Dewar Provisional* fails to render the above claims of the present application obvious, and thus the rejection of those claims under 35 U.S.C. § 103(a) should be withdrawn.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. *See* M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the applied reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. Without conceding any other criteria, Applicant respectfully asserts that the applied *Dewar Provisional* reference does not teach or suggest all the claim limitations, as discussed further below.

#### **A. Independent Claim 1**

For example, independent claim 1 recites, *inter alia*, “based on said desired hiring criteria of said employer, said computer program generating at least one customized application program that is executable to interact with candidates for employment with said employer” (emphasis added). *Dewar Provisional* fails to teach or suggest at least the above limitation of independent claim 1.

*Dewar Provisional* teaches a technique for predicting the job performance of candidates based on a Customer Service/Clerical Potential Index (CS/CPI) determined for the candidates. *See e.g.*, “Background” at page 1 and “Specification” at page 6 of *Dewar Provisional*. The CS/CPI is used to predict both performance and turnover potential for customer service and clerical occupations. *See e.g.*, “Background” at page 1 of *Dewar Provisional*. In general, *Dewar Provisional* teaches that an extensive study was conducted in which job applicants for customer service and clerical positions completed a questionnaire of autobiographical questions. Thereafter, the performance and turnover rate of those job applicants was monitored. From this, a statistical relationship between answers to the autobiographical questions and job performance/turnover rate were determined. Accordingly, *Dewar Provisional* teaches that, once determined, such statistical relationship (e.g., the CS/CPI) may be used for predicting the likely performance of a candidate based on his/her answers to the autobiographical questions.

*Dewar Provisional* fails to provide any discussion of how an application that might present the autobiographical questions to a candidate is generated. Indeed, the only reference in *Dewar Provisional* to the actions that may be performed by a client (employer) in setting up the described solution for questioning candidates and predicting their likely performance/turnover (referred to as the ePredix Solution) is provided in its Fig. 4, which is a flow diagram that is not described (or even mentioned) in the text of *Dewar Provisional*. From the flow diagram of Fig. 4, it appears that a client may go to the ePredix website and log on as a client (box 1 of Fig. 4). Then, it appears that a client may perform one of three tasks on the ePredix website: 1) Set up an ePredix Solution, 2) View Applicant Results, or 3) Set up Applicants for a Selection Solution. If the client decides to set up an ePredix Solution, it appears from box 2 of Fig. 4 that the client may input the details of the job for which they wish to create an ePredix solution. Then, in box 3 of Fig. 4, the client may select from a series of drop down menus the categories that best describe their job. In box 4 of Fig. 4, the client is presented with the option of selecting different components of an ePredix solution (all of which are suitable for the type of job they have). In box 5 of Fig. 4, the client selects components to create an ePredix solution suitable for their job. In box 6 of Fig. 4, the client is provided with a URL and are instructed to add the URL to their online job advertisement. In box 7 of Fig. 4, the client attaches the URL to an online advertisement and awaits applicants to apply.

*Dewar Provisional* fails to teach a “computer program generating at least one customized application program that is executable to interact with candidates for employment with said employer”, as recited by claim 1. The present Office Action asserts, at page 11, item 58, that the flow diagram of Fig. 4 “explains how the invention compiles information and generates a customized program (ePredix Solution), which interacts with candidates for employment with said employer.” Applicant respectfully disagrees and submits that Fig. 4 fails to teach or suggest that a computer program that receives a desired hiring criteria as input generates at least one customized application program. Rather, as discussed further below, Fig. 4 shows receiving information from a client, and then indicates that the client is provided with a URL and are instructed to add the URL to their online job advertisement; but Fig. 4 does not teach or suggest that the application program that is accessed via such URL is generated by the computer program. Instead, a programmer may receive the information input by the client and manually generate the application program to which the URL returned

to the client links.

Thus, the flow diagram of Fig. 4 of *Dewar Provisional* fails to teach that a computer program generates a customized application program for interacting with candidates for employment. As described above, Fig. 4 shows that a client inputs the details of the job for which they wish to create an ePredix solution (box 2). Further, the client selects from a series of drop down menus categories that best describe the job (box 3). And, the client selects components to create an ePredix solution suitable for their job (boxes 4 and 5). Fig. 4 fails to show that a computer program generates a customized application, however. Rather, a programmer, for instance, may presumably receive the input from the client and develop a computer program that satisfies the client's desires, rather than a computer program generating such customized application. Thus, *Dewar Provisional* fails to teach or suggest at least the above identified element of independent claim 1.

#### **B. Independent Claims 30 and 62**

Independent claim 30 recites, *inter alia*, “a computer program executable by said processor-based device to receive as input desired hiring criteria of said employer and generate at least one application program, ... wherein said at least one application program is executable to interact with candidates” (emphasis added). As discussed above with independent claim 1, *Dewar Provisional* fails to teach or suggest a computer program that generates at least one application program, and thus fails to teach or suggest this element of independent claim 30.

Additionally, independent claim 30, as amended herein, recites “wherein said desired hiring criteria specifies at least one attribute to be possessed by a candidate to be considered qualified for a position of employment” (emphasis added). Similarly, independent claim 62, as amended herein, recites “allowing an employer access to a computer executable program, wherein said computer executable program enables said employer to generate at least one customized application program based on a desired hiring criteria of said employer, said desired hiring criteria defining at least one attribute desired to be possessed by a candidate to be considered qualified for a position of employment” (emphasis added).

*Dewar Provisional* further fails to teach or suggest the above elements of claims 30 and 62. As discussed further below, *Dewar Provisional* teaches that a client inputs certain information regarding the position that the employer desires to fill, but *Dewar Provisional* fails to teach or suggest the client inputting information specifying/defining an attribute to be possessed by candidates to be considered qualified for the position. Accordingly, *Dewar Provisional* fails to teach or suggest at least this element of claims 30 and 62.

Again, if in *Dewar Provisional* the client decides to set up an ePredix Solution, it appears from box 2 of Fig. 4 that the client may input the details of the job for which they wish to create an ePredix solution. Then, in box 3 of Fig. 4, the client may select from a series of drop down menus the categories that best describe their job. In box 4 of Fig. 4, the client is presented with the option of selecting different components of an ePredix solution (all of which are suitable for the type of job they have). In box 5 of Fig. 4, the client selects components to create an ePredix solution suitable for their job. In box 6 of Fig. 4, the client is provided with a URL and are instructed to add the URL to their online job advertisement. In box 7 of Fig. 4, the client attaches the URL to an online advertisement and awaits applicants to apply.

Box 5 of Fig. 4 of *Dewar Provisional* provides that the client selects “components” to create an ePredix solution suitable for their job. What is meant by the term “components” as used in Fig. 4 is not mentioned or described anywhere in the *Dewar Provisional* application. *Dewar Provisional* does describe that 4 separate categories of questions may be used in screening a candidate: 1) Application Questions, 2) Customer Service, 3) Working with Information, and 4) Sales Potential Inventory. Assuming that each of those categories is a “component” (without conceding that point), this does not teach the employer inputting information specifying/defining an attribute to be possessed by candidates to be considered qualified for the position. Rather, this identifies the categories of questions that may be asked of the candidates for a given position (e.g., customer service type position, etc.). The questions associated with each of the categories in *Dewar Provisional* appear to be pre-defined questions developed through the extensive study as being able to predict candidate’s performance/turnover likelihood, and thus the employer does not input information specifying/defining an attribute to be possessed by candidates to be considered qualified for the position, but instead the employer identifies the type of position to be filled (e.g.,

customer service type position) and the pre-defined questions of the extensive study that are associated with that position type are used for interviewing candidates.

### C. Independent Claim 54

Independent claim 54 recites, *inter alia*, “code for generating at least one qualification program for interacting with candidates” (emphasis added). As discussed above with independent claim 1, *Dewar Provisional* fails to teach or suggest a computer program that generates at least one application program, and thus fails to teach or suggest this element of independent claim 54.

Additionally, independent claim 54, as amended herein, recites “code for presenting a user interface for receiving preferences from said employer regarding operational characteristics of at least one qualification program to be generated; and code for generating at least one qualification program for interacting with candidates in accordance with said received preferences” (emphasis added). *Dewar Provisional* fails to teach or suggest this further element of claim 54. That is, *Dewar Provisional* does not teach or suggest computer-executable code for receiving preferences from an employer regarding operational characteristics of a qualification program to be generated. Rather, *Dewar Provisional* teaches that a client inputs certain information regarding the position that the employer desires to fill, but *Dewar Provisional* fails to teach or suggest the client inputting preferences regarding the operational characteristics of at least one qualification program to be generated. Accordingly, *Dewar Provisional* fails to teach or suggest at least this element of claim 54.

Again, if in *Dewar Provisional* the client decides to set up an ePredix Solution, it appears from box 2 of Fig. 4 that the client may input the details of the job for which they wish to create an ePredix solution. Then, in box 3 of Fig. 4, the client may select from a series of drop down menus the categories that best describe their job. In box 4 of Fig. 4, the client is presented with the option of selecting different components of an ePredix solution (all of which are suitable for the type of job they have). In box 5 of Fig. 4, the client selects components to create an ePredix solution suitable for their job. In box 6 of Fig. 4, the client is provided with a URL and are instructed to add the URL to their online job advertisement. In box 7 of Fig. 4, the client attaches the URL to an online advertisement and awaits applicants to apply.

In view of the above, Fig. 4 of *Dewar Provisional* describes certain information regarding the position that the employer desires to fill, but *Dewar Provisional* fails to teach or suggest the client inputting preferences regarding the operational characteristics of at least one qualification program to be generated. Further, newly added dependent claims 84 and 85 further recite types of preferences that may be input regarding the operational characteristics of the at least one qualification program to be generated, and *Dewar Provisional* fails to teach or suggest the client inputting such preferences.

**D. Dependent Claims 2-3, 5-20, 28-29, 31-43, 46, 48-53, 55-61, and 63-70**

Further, dependent claims 2-3, 5-20, 28-29, 31-43, 46, 48-53, 55-61, and 63-70 have been rejected under 35 U.S.C. § 103(a) as unpatentable over *Dewar*. In view of the above, Applicant respectfully submits that independent claims 1, 30, 54, and 62 are not obvious under 35 U.S.C. § 103(a) over *Dewar* because *Dewar Provisional* fails to teach or suggest every element of those independent claims. Further, each of dependent claims 2-3, 5-20, 28-29, 31-43, 46, 48-53, 55-61, and 63-70 depend either directly or indirectly from one of independent claims 1, 30, 54 and 62, and thus inherit all limitations of the respective independent claims from which they depend. It is respectfully submitted that dependent claims 2-3, 5-20, 28-29, 31-43, 46, 48-53, 55-61, and 63-70 are allowable not only because of their dependency from their respective independent claims for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compel a broader interpretation of the respective base claim from which they depend).

For example, dependent claim 2 recites “wherein said desired hiring criteria includes at least one criteria selected from the group consisting of: candidate’s education, candidate’s work experience, candidate’s possessing a particular license, candidate’s language skills, and candidate’s computer skills.” *Dewar Provisional* fails to teach or suggest a computer program receiving as input from an employer such desired hiring criteria as those recited in claim 2. As mentioned above, box 5 of Fig. 4 of *Dewar Provisional* provides that the client selects “components” to create an ePredix solution suitable for their job. What is meant by the term “components” as used in Fig. 4 is not mentioned or described anywhere in the *Dewar Provisional* application. As mentioned above, *Dewar Provisional* does describe that 4 separate categories of questions may be used in screening a candidate: 1) Application



Questions, 2) Customer Service, 3) Working with Information, and 4) Sales Potential Inventory. Assuming that each of those categories is a “component” (without conceding that point), this does not teach or suggest the employer inputting any of the types of hiring criteria identified in claim 2. Rather, the questions associated with each of the categories in *Dewar Provisional* appear to be pre-defined questions developed through the extensive study as being able to predict candidate’s performance/turnover likelihood, and thus the employer does not input the types of hiring criteria as those identified in claim 2. Accordingly, the above element of claim 2 is not taught or suggested by *Dewar Provisional*.

As another example, claim 16 recites “wherein said computer program receives as input from said employer indication of one or more communication platforms on which said at least one customized application program is to enable access by candidates.” *Dewar Provisional* fails to teach or suggest this element of claim 16. That is, *Dewar Provisional* fails to teach or suggest that an employer may input to a computer program an indication of one or more communication platforms on which a customized application program is to enable access by candidates. As mentioned above, Fig. 4 of *Dewar Provisional* appears to be the only mention of the actions taken by the employer in setting up an ePredix Solution, and Fig. 4 fails to show this type of input from an employer. Accordingly, this element of claim 16 is not taught or suggested by *Dewar Provisional*.

As still another example, claim 41 recites “wherein said computer program is executable to generate a plurality of said application programs.” *Dewar Provisional* fails to teach or suggest this element of claim 41. As mentioned above with regard to independent claims 1, 30, 54, and 62, *Dewar Provisional* fails to teach or suggest a computer program executable to generate an application program. Thus, *Dewar Provisional* fails to teach or suggest a computer program that is executable to generate a plurality of such application programs, as recited by claim 41. Accordingly, this element of claim 41 is not taught or suggested by *Dewar Provisional*.

As still another example, claim 42 recites “wherein each of said plurality of application programs is executable to enable interaction with candidates via a different communication platform.” *Dewar Provisional* simply fails to teach or suggest this element of claim 42. That is, *Dewar Provisional* provides no mention of generating a plurality of application programs that are each executable to enable interaction with candidates via a

different communication platform. Instead, *Dewar Provisional* teaches providing a client a URL that is presumably linked to an application program to enable interaction by clients with such application program via the web. Accordingly, this element of claim 42 is not taught or suggested by *Dewar Provisional*.

#### **V. Claim Rejections Under 35 U.S.C. § 103(a) over *Dewar* in view of *McGovern***

Claims 4, 22-27, 44, 45, 47, and 72-77 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dewar* in view of *McGovern*. As discussed above, Applicant respectfully submits that independent claims 1, 30, 54, and 62 are of patentable merit. Further, each of dependent claims 4, 22-27, 44, 45, 47, and 72-77 depend either directly or indirectly from one of independent claims 1, 30, 54, and 62, and thus inherit all limitations of the respective independent claims from which they depend. It is respectfully submitted that dependent claims 4, 22-27, 44, 45, 47, and 72-77 are allowable not only because of their dependency from their respective independent claims for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compel a broader interpretation of the respective base claim from which they depend).

#### **VI. Claim Rejections Under 35 U.S.C. § 103(a) over *Dewar* in view of *Haverstock***

Claims 21 and 71 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dewar* in view of *Haverstock*. As discussed above, Applicant respectfully submits that independent claims 1 and 62 are of patentable merit. Further, each of dependent claims 21 and 71 depend either directly or indirectly from one of independent claims 1 and 62, and thus inherit all limitations of the respective independent claims from which they depend. It is respectfully submitted that dependent claims 21 and 71 are allowable not only because of their dependency from their respective independent claims for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compel a broader interpretation of the respective base claim from which they depend).

#### **VII. New Claims 78-87**

New claims 78-87 are added herein. Each of the newly added claims depends, either directly or indirectly, from one of independent claims 1, 30, 54, and 62. As discussed above,

Applicant respectfully submits that independent claims 1, 30, 54, and 62 are of patentable merit. It is respectfully submitted that newly added claims 78-87 are allowable not only because of their dependency from their respective independent claims for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compel a broader interpretation of the respective base claim from which they depend).

### **VIII. Conclusion**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

The required fee for this response is enclosed. If any additional fee is due, please charge deposit Account No. 06-2380, under Order No. 59428/P001US/10020580 from which the undersigned is authorized to draw.

Dated: April 8, 2004

Respectfully submitted,

By   
Jody C. Bishop  
Registration No.: 44,034  
FULBRIGHT & JAWORSKI L.L.P.  
2200 Ross Avenue, Suite 2800  
Dallas, Texas 75201-2784  
(214) 855-8007  
(214) 855-8200 (Fax)  
Attorney for Applicant